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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,960	11/27/2001	Koji Tokunaga	15124	1702
23389	7590	06/29/2005	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			KAROVALIA, SAMIR	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/994,960	TOKUNAGA, KOJI	
	Examiner	Art Unit	
	Samir S. Karovalia	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/29/03, 06/01/04, 08/01/03, 02/28/02, 04/12/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the reply filed on January 31, 2005. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

Drawings

2. The drawings 1/3 and 2/4 filed on September 22, 2004 have been accepted.

3. The drawings 3/4 and 4/4 are objected to because figure 3 and 4 are not labeled properly for example in figure 3, labels 11 and 12 represent individual memory areas, thus should be marked accordingly as memory area 1 and memory area 2. Further, label 21 in figure 3 and similarly labels addressed in figure 4 should be marked as state 1, state 2, and so on. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR

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1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua et al. (US Pat. 6,222,909) in view of McNelley et al. (US Pat. 5,550,754).

The claims read on Qua as follows: Qua teaches as pertains to claim 1,
A portable phone having a recording function for recording audio data during telephone conversation,
(see abstract; figure 1; col.1,ln.39-44; col.3,ln.22-27 which teaches a wireless phone)

said portable phone comprising: a plurality of memories, each [memory] for endless recording, as a conversation content, the audio data during the telephone conversation;

(in accordance with claim 2 limitations, the 2 memories are considered merely different memory areas of a single memory device. Qua teaches a single device by reference to the detachable storage unit 120 for example. Further, Qua teaches to be able to mark each of the portions of a conversation for later retrieval. The marking of a recorded audio data is considered to record the data in a different memory area in the single memory, as upon retrieval, that specific portion of memory would be accessed to retrieve the data in that location., col.3,ln.22-29 col.3,ln.44-47; col.5,ln.3-7; col.5,ln.25-31; col.5,ln.36-39)

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a switching unit capable of switching said memories from a first memory of said memories to a second memory of said memories so that said second memory endless-records the audio of a current conversation data instead of said first memory which endless-records, as the conversation content, the audio data until then;

(Qua teaches the user enable to mark the audio data by initiating recording as noted above via col.5,ln.36-39, the marking is indicating the different memory area for use in later retrieval, and as the marking is enabled by a user input such is considered a switch as claimed herein as an activation sequence from the user is done via keypad, figure 2, 202-220)

and

a reproducing unit for reproducing the conversation content which said first memory endless-recorded before being switched by said switching unit, while the second memory endless-records the current conversation.

(Qua teaches the retrieval of audio notes via identification code, identifying the memory area of the stored note for retrieval col.6,ln.26-39 with use of similar types of control as for the recording as well as for replay (reproduction) col.6,ln.51-54 and thus each and every part of a sequence of notes including the one that was recorded in the first memory area can be reproduced. Qua fails to teach that a first memory reproduces a conversation content recorded, while the second memory records conversation contents of a current conversation.

However, McNelley et al discloses a method in which a single recording device can play and record simultaneously through a configuration similar to the one proposed above where contents of the first memory are reproduced as the second memory endless-records. McNelley et al discloses that single digital storage mediums having short access times can be used to record and play at the same time (col. 12,ln 56-63).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use the storage method provided by McNelley et al with the teachings of Qua et al to provide Qua et al's audio note taking system with further capabilities to play a previously stored message content on a single or plurality of memories in which a conversation is reproduced from the first memory while another memory endless-records current conversation. One skilled in the art would have been motivated to combine the teachings of Qua et al and McNelley et al to provide an improvement in that the audio note taking system can multitask or rather play and record at the same time).

As pertains to claim 2, Qua teaches

the memories are constituted by a plurality of memory areas of a single memory device, (storage unit 120) as was noted above,

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each of the memory areas being capable of individually endless-recording the audio data.

(in as far as 'endless-recording' is understood and defined by the disclosure, Qua teaches recording audio until the user or call is ended, each memory of the plural memory areas can contain the whole note or different memory areas can hold different portions of the audio note depending on the manner in which the user marks the audio note via the 'switching')

As pertains to claim 3, Qua teaches a key for operating said reproducing unit to reproduce the audio data; said reproducing unit successively reproducing the conversation contents in the order of recording in which said memories records the conversation contents.

(Qua teaches implantation of the various functions via keypad input col.6,ln.59-col.7,ln.12)

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

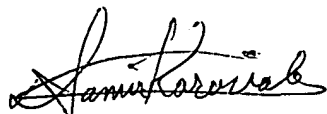
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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samir S. Karovalia whose telephone number is (571)272-8133.

The examiner can normally be reached on Monday-Friday, 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571)272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Samir Karovalia
Art Unit: 2645
06/10/05

OVIDIO ESCALANTE
PATENT EXAMINER

